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Richard A Romanchik
NexPress digital LLC
2600 Manitou Road
Rochester, NY 14624

| EXAMINER |
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THOMPSON, JAMES A

| ART UNIT | PAPER NUMBER |
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| 2624 | |

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,302

Applicant(s)

HANSEN, DAVID R.

Examiner

James A Thompson

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date A.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 8 March 2001 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file and the accompanying document has been fully considered, but no PTO-1449 has been attached, though there is a statement in the Information Disclosure Statement that a PTO-1449 document has been included.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-14, 16-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Motoyama (US Patent 5,353,388).

Claim 2 performs the method of claim 1. Claims 1 and 2 are therefore discussed together.

Claim 11 performs the method of claim 10. Claims 10 and 11 are therefore discussed together.

Claims 6 and 14 disclose the same limitations and are therefore discussed together.

Claims 8 and 16 disclose the same limitations and are therefore discussed together.

Regarding claims 1 and 2: Motoyama discloses a computer readable medium, having stored therein instructions (figure 3(200-206) of Motoyama) for causing a central processing unit (figure 3(150) of Motoyama) to execute a method (column 5, lines 50-52 of Motoyama) comprising the step of searching an electronic version of the document (column 10, lines 34-40 of Motoyama) for an identifier for the group of pages (column 3, lines 49-54 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-51 of Motoyama). The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section in order to search through the hierarchy.

Motoyama further discloses gathering each section of the electronic version that is associated with the identifier into an output data stream (column 10, lines 34-40 of Motoyama); and directing the output data stream to the printing device for printing (column 11, lines 38-43 of Motoyama).

Regarding claim 3: Motoyama discloses requesting a selection of the printing device on which to print the group of pages (column 11, lines 18-24 of Motoyama).

Regarding claim 4: Motoyama discloses that the identifier is stored in a separate section (prologue) of the electronic version of the document (column 3, lines 49-59 of Motoyama). Since the PDL file is divided into page sets and pictures (column 3, lines 49-52 of Motoyama) and said page sets and pictures have their own prologue sections (column 3, lines 49-54 of Motoyama), said prologue sections are therefore stored in each of the separate page sets and picture sections. The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section.

Motoyama further discloses that said separate section comprises location information for each section of the electronic version of the document that is associated with the group of pages (column 3, lines 54-59 of Motoyama). Since the declarations and definitions of each prologue section are only applicable to the corresponding subset of the document (column 3, lines 54-59 of Motoyama), location information must also be included. Otherwise, it would not be possible to obtain the data to operate upon.

Regarding claim 5: Motoyama discloses that the identifier is stored in each section of the electronic version of the document (column 3, lines 54-59 of Motoyama) that is associated with the group of pages (column 3, lines 49-54 of Motoyama). The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section. Each prologue section is stored as part of their associated page set or picture section (column 3, lines 49-54 of Motoyama).

Regarding claims 10 and 11: Motoyama discloses a computer readable medium, having stored therein instructions (figure 3(200-206) of Motoyama) for causing a central processing unit (figure 3(150) of Motoyama) to execute a method (column 5, lines 50-52 of Motoyama) comprising the steps of assigning an identifier (figure 1a(110) and column 4, table 1 of Motoyama) to a group of pages (column 3, lines 52-59 of Motoyama); and associating the identifier with sections of an electronic version of the document that correspond to the group of pages (column 4, lines 34-38 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-51 of Motoyama).

Regarding claims 6 and 14: Motoyama discloses that the electronic version of the document is in a Page Description Language (column 3, lines 49-51 of Motoyama).

Regarding claims 8 and 16: Motoyama discloses that the identifier is a metatag (column 7, lines 14-23 of Motoyama). A metatag is a comment in a page description language file that describes the contents of the document. The definitions of the identifier (figure 1a(110) and column 4, table 1 of Motoyama) and the associated comments under "prologue" (column 7, lines 14-23 of Motoyama) and the fact that the prologue is in the "comment" section (column 6, line 64 to column 7, line 24 of Motoyama) shows that the identifier is a metatag.

Regarding claim 9: Motoyama discloses searching the electronic version of the document for another identifier for another group of pages (column 10, lines 34-40 of Motoyama). Since the document structure manager (figure 6(300) of Motoyama) provides the appropriate dictionaries for a plurality of sections that are to be printed

(column 10, lines 34-40 of Motoyama), said dictionaries being associated with each section (column 3, lines 60-62 of Motoyama), then another identifier associated with another group of pages is search for.

Motoyama further discloses directing an insert command to the printing device for each section that is associated with the other identifier (column 10, lines 38-40 of Motoyama). Pushing the appropriate dictionaries for the section of the document selected for printing (column 10, lines 38-40 of Motoyama) is an insert command since pushing the dictionary data inserts said dictionary data into the memory for printing.

Regarding claim 12: Motoyama discloses storing the identifier in a separate section (prologue) of the electronic version of the document (column 3, lines 49-59 of Motoyama). Since the PDL file is divided into page sets and pictures (column 3, lines 49-52 of Motoyama) and said page sets and pictures have their own prologue sections (column 3, lines 49-54 of Motoyama), said prologue sections are therefore stored in each of the separate page sets and picture sections. The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section.

Motoyama further discloses that said separate section comprises location information for the sections of the electronic version of the document that correspond to the group of pages (column 3, lines 54-59 of Motoyama). Since the declarations and definitions of each prologue section are only applicable to the corresponding subset of

the document (column 3, lines 54-59 of Motoyama), location information must also be included. Otherwise, it would not be possible to obtain the data to operate upon.

Regarding claim 13: Motoyama discloses storing the identifier in the sections of the electronic version of the document (column 3, lines 54-59 of Motoyama) that correspond to the group of pages (column 3, lines 49-54 of Motoyama). Each prologue section, and therefore the associated identifier, is stored as part of their associated page set or picture section (column 3, lines 49-54 of Motoyama).

Regarding claim 17: Motoyama discloses a digital printing system (figure 3 of Motoyama) comprising at least one printing device (figure 3(Printer A) of Motoyama); and a computer (figure 3(150) of Motoyama) connected to the at least one printing device (column 5, lines 27-32 of Motoyama).

Said computer executes a program (column 5, lines 50-52 of Motoyama) that performs the steps of gathering each section of the electronic version of a document associated with an identifier (figure 1a(110) and column 4, table 1 of Motoyama) into an output data stream (column 10, lines 34-40 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-51 of Motoyama); associating the identifier with a printing device (column 11, lines 18-21 of Motoyama) selected from the at least one printing device (column 11, lines 18-24 of Motoyama); and directing the output data stream to the selected printing device for printing (column 11, lines 38-43 of Motoyama). Since the selected printer prints the desired section of the electronic document (column 11, lines 38-43 of Motoyama), said printer is therefore associated with the identifier.

Regarding claim 19: Motoyama discloses a method comprising the steps of selecting a group of pages of a document (column 4, lines 34-38 of Motoyama), wherein the group of pages is defined according to a common attribute (column 4, lines 12-18 of Motoyama). Structuring the overall electronic document into distinct document segments (column 4, lines 34-38 of Motoyama) inherently requires that a group of pages of said document is selected. Otherwise, it is not possible to structure said document into various segments. Each page set of a document segment is defined with particular definitions (column 4, lines 12-18 of Motoyama), so the pages of said page set must therefore have at least one common attribute, as defined by said definitions.

Motoyama further discloses assigning an identifier to the group of pages (figure 1a(110) and column 4, lines 12-16 of Motoyama).

Motoyama further discloses associating a printing device with the assigned identifier (column 11, lines 38-43 of Motoyama). Since the selected printing device prints the desired section of the electronic document (column 11, lines 38-43 of Motoyama), said printing device is therefore associated with the identifier.

Motoyama further discloses inputting the assigned identifier to the digital printing system in response to a print prompt (column 11, lines 18-21 of Motoyama), whereby the associated printing device prints the group of pages having the associated identifier (column 11, lines 38-43 of Motoyama). The identifier (figure 1a(110) of Motoyama) contains the definitions and declarations needed for the document section (column 4, lines 13-18 of Motoyama), which would include the handler that determines which

image driver program is used when a print task is to be performed (column 11, lines 18-21 of Motoyama).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 15 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Geschke (Preface to *PDF Reference 2nd Edition, Adobe Portable Document Format version 1.3*, by Chuck Geschke and John Warnock, March 2000).

Claims 7 and 15 disclose the same limitations and are therefore discussed together.

Claims 20 and 21 disclose the same limitations and are therefore discussed together.

Claims 22 and 23 disclose the same limitations and are therefore discussed together.

Regarding claims 7 and 15: Motoyama does not disclose expressly that the Page Description Language is a Portable Document Format.

Geschke discloses using a Portable Document Format (page xvi, lines 1-3 of Geschke).

Motoyama and Geschke are combinable because they are from the same field of endeavor, namely the handling of page description language data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a Portable Document Format as the specific Page Description Language. The motivation for doing so would have been that the Portable Document Format has become the *de facto* standard for electronic information exchange (page xvi, lines 6-8 of Geschke). Therefore, it would have been obvious to combine Geschke with Motoyama to obtain the invention as specified in claims 7 and 15.

Regarding claims 20 and 21: Motoyama discloses a computer readable medium, having stored therein instructions (figure 3(200-206) of Motoyama) for causing a central processing unit (figure 3(150) of Motoyama) to execute a method (column 5, lines 50-52 of Motoyama) comprising the step of searching for an identifier for the group of pages (column 3, lines 49-54 of Motoyama) in a separate section of an electronic version of the document (column 4, lines 34-38 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-51 of Motoyama). The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section in order to search through the hierarchy.

Motoyama further discloses that said separate section comprises location information for each section of the electronic version of the document that is associated with the group of pages (column 3, lines 54-59 of Motoyama). Since the declarations

and definitions of each prologue section are only applicable to the corresponding subset of the document (column 3, lines 54-59 of Motoyama), location information must also be included. Otherwise, it would not be possible to obtain the data to operate upon.

Motoyama further discloses gathering each section of the electronic version of the electronic version that is associated with the identifier into an output data stream (column 10, lines 34-40 of Motoyama).

Motoyama further discloses directing the output data stream to the printing device for printing (column 11, lines 38-43 of Motoyama).

Motoyama does not disclose expressly that said electronic version of the document is in a Portable Document Format.

Geschke discloses using a Portable Document Format (page xvi, lines 1-3 of Geschke).

Motoyama and Geschke are combinable because they are from the same field of endeavor, namely the handling of page description language data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a Portable Document Format as the format of the electronic version of the document. The motivation for doing so would have been that the Portable Document Format has become the *de facto* standard for electronic information exchange (page xvi, lines 6-8 of Geschke). Therefore, it would have been obvious to combine Geschke with Motoyama to obtain the invention as specified in claims 20 and 21.

Regarding claims 22 and 23: Motoyama discloses a computer readable medium, having stored therein instructions (figure 3(200-206) of Motoyama) for causing

a central processing unit (figure 3(150) of Motoyama) to execute a method (column 5, lines 50-52 of Motoyama) comprising the step of assigning an identifier (figure 1a(110) and column 4, table 1 of Motoyama) to a group of pages (column 3, lines 52-59 of Motoyama).

Motoyama further discloses storing the identifier in a separate section of an electronic version of the document (column 4, lines 36-38 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-52 of Motoyama).

Motoyama further discloses that said separate section comprises location information for the sections of the electronic version of the document that correspond to the group of pages (column 3, lines 54-59 of Motoyama). Since the declarations and definitions of each prologue section are only applicable to the corresponding subset of the document (column 3, lines 54-59 of Motoyama), location information must also be included. Otherwise, it would not be possible to obtain the data to operate upon.

Motoyama does not disclose expressly that said electronic version of the document is in a Portable Document Format.

Geschke discloses using a Portable Document Format (page xvi, lines 1-3 of Geschke).

Motoyama and Geschke are combinable because they are from the same field of endeavor, namely the handling of page description language data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a Portable Document Format as the format of the electronic version of the document. The

motivation for doing so would have been that the Portable Document Format has become the *de facto* standard for electronic information exchange (page xvi, lines 6-8 of Geschke). Therefore, it would have been obvious to combine Geschke with Motoyama to obtain the invention as specified in claims 22 and 23.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Webster (US Patent 5,710,635).

Regarding claim 18: Motoyama does not disclose expressly that the program is a plug-in to a Print Document Management System.

Webster discloses image print processing programs that are plug-in components (column 13, lines 11-16 of Webster) to a Print Document Management System (column 13, lines 1-5 of Webster). A machine that manages an input stream of data that is to be printed (column 13, lines 1-5 of Webster) is a Print Document Management System.

Motoyama and Webster are combinable because they are from the same field of endeavor, namely the processing of print data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make the program taught by Motoyama a plug-in component, as taught by Webster. The motivation for doing so would have been to allow a third-party vendor to make their own plug-in components (column 13, lines 16-19 of Webster). Therefore, it would have been obvious to combine Webster with Motoyama to obtain the invention as specified in claim 18.

7. Claims 24-28, 30-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Kato (US Patent 5,978,557).

Claims 25-28 disclose the same limitations as claims 33-36, respectively. Claims 25-28 are therefore discussed together with claims 33-36, respectively.

Claims 30-31 disclose the same limitations as claims 38-39, respectively. Claims 30-31 are therefore discussed together with claims 38-39, respectively.

Regarding claim 24: Motoyama discloses a method comprising the step of searching an electronic version of the document (column 10, lines 34-40 of Motoyama) for an identifier for the group of pages (column 3, lines 49-54 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-51 of Motoyama). The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section in order to search through the hierarchy.

Motoyama further discloses gathering each section of the electronic version that is associated with the identifier into an output data stream (column 10, lines 34-40 of Motoyama); and directing the output data stream to the printing device for printing (column 11, lines 38-43 of Motoyama).

Motoyama further discloses directing the output data stream to the printing device for printing the identified group of pages (column 11, lines 38-43 of Motoyama).

Motoyama does not disclose expressly replacing pages not identified with a media insertion.

Kato discloses replacing pages not identified with a media insertion (column 5, lines 39-42 of Kato).

Motoyama and Kato are combinable because they are from the same field of endeavor, namely the control of image and document printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to set replacement page insertion positions, as taught by Kato. The motivation for doing so would have been to keep track of where to insert pages that are printed by separate printers (column 5, lines 43-49 of Kato). Therefore, it would have been obvious to combine Kato with Motoyama to obtain the invention as specified in claim 24.

Regarding claim 32: Motoyama discloses a method comprising the step of searching an electronic version of the document (column 10, lines 34-40 of Motoyama) for an identifier for a group of pages (column 3, lines 49-54 of Motoyama), wherein each page of the document is associated with a corresponding section of the electronic version of the document (column 4, lines 47-51 of Motoyama). The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section in order to search through the hierarchy.

Motoyama further discloses gathering each section of the electronic version that is associated with the identifier into an output data stream (column 10, lines 34-40 of Motoyama); and directing the output data stream (column 11, lines 38-43 of Motoyama).

Motoyama further discloses directing the output data stream to the printing device for printing the document (column 11, lines 38-43 of Motoyama).

Motoyama does not disclose expressly replacing pages not in the first group with a media insertion.

Kato discloses replacing pages not in the first group (monochromatic pages) with a media insertion (column 5, lines 39-42 of Kato).

Motoyama and Kato are combinable because they are from the same field of endeavor, namely the control of image and document printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to set replacement page insertion positions, as taught by Kato. The motivation for doing so would have been to keep track of where to insert pages that are printed by separate printers (column 5, lines 43-49 of Kato). Therefore, it would have been obvious to combine Kato with Motoyama to obtain the invention as specified in claim 32.

Regarding claims 25 and 33: Motoyama discloses requesting a selection of the printing device on which to print the group of pages (column 11, lines 18-24 of Motoyama).

Regarding claims 26 and 34: Motoyama discloses that the identifier is stored in a separate section (prologue) of the electronic version of the document (column 3, lines 49-59 of Motoyama). Since the PDL file is divided into page sets and pictures (column 3, lines 49-52 of Motoyama) and said page sets and pictures have their own prologue sections (column 3, lines 49-54 of Motoyama), said prologue sections are therefore stored in each of the separate page sets and picture sections. The prologue sections

are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section.

Motoyama further discloses that said separate section comprises location information for each section of the electronic version of the document that is associated with the group of pages (column 3, lines 54-59 of Motoyama). Since the declarations and definitions of each prologue section are only applicable to the corresponding subset of the document (column 3, lines 54-59 of Motoyama), location information must also be included. Otherwise, it would not be possible to obtain the data to operate upon.

Regarding claims 27 and 35: Motoyama discloses that the identifier is stored in each section of the electronic version of the document (column 3, lines 54-59 of Motoyama) that is associated with the group of pages (column 3, lines 49-54 of Motoyama). The prologue sections are organized hierarchically (column 3, lines 54-59 of Motoyama), so there must be an associated identifier (figure 1a(110) and column 4, table 1 of Motoyama) stored with each prologue section. Each prologue section is stored as part of their associated page set or picture section (column 3, lines 49-54 of Motoyama).

Regarding claims 28 and 36: Motoyama discloses that the electronic version of the document is in a Page Description Language (column 3, lines 49-51 of Motoyama).

Regarding claims 30 and 38: Motoyama discloses that the identifier is a metatag (column 7, lines 14-23 of Motoyama). A metatag is a comment in a page description language file that describes the contents of the document. The definitions of

the identifier (figure 1a(110) and column 4, table 1 of Motoyama) and the associated comments under “prologue” (column 7, lines 14-23 of Motoyama) and the fact that the prologue is in the “comment” section (column 6, line 64 to column 7, line 24 of Motoyama) shows that the identifier is a metatag.

Regarding claims 31 and 39: Motoyama discloses searching the electronic version of the document for another identifier for another group of pages (column 10, lines 34-40 of Motoyama). Since the document structure manager (figure 6(300) of Motoyama) provides the appropriate dictionaries for a plurality of sections that are to be printed (column 10, lines 34-40 of Motoyama), said dictionaries being associated with each section (column 3, lines 60-62 of Motoyama), then another identifier associated with another group of pages is search for.

Motoyama further discloses directing an insert command to the printing device for each section that is associated with the other identifier (column 10, lines 38-40 of Motoyama). Pushing the appropriate dictionaries for the section of the document selected for printing (column 10, lines 38-40 of Motoyama) is an insert command since pushing the dictionary data inserts said dictionary data into the memory for printing.

8. Claims 29 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Kato (US Patent 5,978,557) and Geschke (Preface to *PDF Reference 2nd Edition, Adobe Portable Document Format version 1.3*, by Chuck Geschke and John Warnock, March 2000).

Claims 29 and 37 disclose the same limitations and are therefore discussed together.

Regarding claims 29 and 37: Motoyama in view of Kato does not disclose expressly that the Page Description Language is a Portable Document Format.

Geschke discloses using a Portable Document Format (page xvi, lines 1-3 of Geschke).

Motoyama in view of Kato is combinable with Geschke because they are from the same field of endeavor, namely the control of image and document printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a Portable Document Format as the specific Page Description Language. The motivation for doing so would have been that the Portable Document Format has become the *de facto* standard for electronic information exchange (page xvi, lines 6-8 of Geschke). Therefore, it would have been obvious to combine Geschke with Motoyama to obtain the invention as specified in claims 29 and 37.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ishikawa et al., US Patent 5,987,226, 16 November 1999.

Kawamoto et al., US Patent 5,978,563, 2 November 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A Thompson whose telephone number is 703-305-6329. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 703-308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624

JAT
July 9, 2004



Thomas D.
~~TONER~~ LEE
PRIMARY EXAMINER